

REMARKS

Claim 20 has been amended to correct a typographical error by inserting "rail" after the words "at least one" in line 3 of Claim 20.

The Office Action mailed June 11, 2009 has been carefully reviewed and considered. Claims 1, 5, 11-14, 16-23, 38-40 and 42-44 are in this application. All of the claims have been rejected under 35 U.S.C. § 103(a). For the reasons set forth below, Applicants respectfully traverse the rejections in the Action.

In traversing the points made in the Action, it is important to note the applicable law regarding the evaluation of the obviousness question by the methodology of combining a plurality of references to posit a case of prima facie obviousness. Whenever the combination of references methodology is used, a patent examiner or court runs the risk of falling afoul of the U.S. Supreme Court's admonition in KSR Int'l Co.:

As is clear from cases such as Adams, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 418-419 (2007)(emphasis added.)

KSR, and other Supreme Court and Federal Circuit law articulate other well-established rules to be followed to ensure that the combining of references does not go so far as to swerve into a hindsight reconstruction of known devices that leads to an erroneous finding of prima facie obviousness of a claimed invention. These include, but are not limited to, the following rules:

First, the Federal Circuit's long standing "teaching, suggestion or motivation" test "provides helpful insight into the obvious question as long as it is not applied to rigidly." Thus, even post KSR, it is still important to determine whether there is a teaching, suggestion or

motivation in the prior art to combine references before concluding that a claimed invention is prima facie obvious. Procter & Gamble Co. v. Teva Pharmaceuticals USA, Inc., 566 F.3d 989, 994 (Fed. Cir. 2009).

Second, "before the PTO may combine the disclosure of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." In re Jones, 958 F.2d 347, 351 (Fed. Cir. 1992)(emphasis added.)

Third, in evaluating obviousness, the claim and the entire prior art must be read as a whole; one "cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention." SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 887-888 (Fed. Cir. 1988)(emphasis added.)("A holding that combination claims are invalid based upon finding similar elements in separate prior art patents would be contrary to statute and would defeat the congressional purpose in enacting Title 35.")(Emphasis added.)

Fourth, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. In re Mills, 916 F.2d 680 (Fed. Cir. 1990)(emphasis added.)

Fifth, prima facie obviousness cannot be found on the basis of combinations of references with the use of hindsight. In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992); Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc., 73 F.3d 1085 (Fed. Cir. 1995).

Sixth, prima facie obviousness cannot be found in view of the teachings or suggestions of the claimed invention. Id.

Seventh, there must be "actual evidence" that one of ordinary skill in the art would make the claimed combination so as to avoid the appearance of an arbitrary agency decision. In re Lee, 277 F.3d 1338 (Fed Cir. 2002); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999)(emphasis added.)

Eighth, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385 (C.C.P.A. 1970); MPEP 2141.02.

As another preliminary matter, which is applicable to all of the rejections in the Action, including those based upon the combination of Lucas and Wankow, and the Chuang reference

and device, one must point to one very important distinction between the prior art and the claimed invention. As Mr. Vegliante points out in his Supplemental Declaration submitted herewith, none of the cited prior art references discloses a rail surface that provides cohesion between a rail surface and the film, as opposed to friction or adhesion, to enable the film to be cut by the cutter blade, both before during and after cutting. Cohesion, adhesion and friction are scientifically different instrumentalities. Cohesion or cohesive attraction is a property of substances, *caused by the intermolecular attraction between like-molecules* within the substances or materials that act to unite them. Adhesion is the tendency of certain *dissimilar molecules* to cling together due to attractive forces. Friction or dry friction uses a *static charge* to create an attraction between the surfaces of materials. The use of cohesion in the rail cutter of the instant invention, by *intermolecular attraction* of like molecules, is unique over the prior art in that it very firmly holds the film to be cut in place, before, during and after cutting, in a manner that is superior to the prior art devices that use friction, vinyl spots, rollers, hand pressure and similar means, as disclosed in the cited art.

Wankow, the only reference that arguably uses vinyl spots for some cohesion, teaches away from the present invention. Wankow's vinyl spots do have cohesion but are used to stop static cling from pulling the film back inside the box. The vinyl spots of Wankow teach away from the invention because they are positioned on the opposite side of the serrated cutting blade. The serrated cutting blade acts as a fulcrum where the opposite side of the vinyl spots needs to have hard, quick movement in order to serrate the film against the blade. The argument that Wankow's spots help in cutting goes against the laws of physics. On one side of the fulcrum Wankow uses three spots with very small cling properties to hold the film still (which is 1/10 the thickness and weight of paper). Very little cling is needed to avert the forces of static friction. On the opposite side, by way of common sense and physics, the cutting blade needs movement of the film and substantial downward pressure to cut the film on the static serrated blade. The claim that it aids in cutting is without merit. Because Wankow's spots have nothing to do with the cutting operation the claim that the combination of Lucas and Wankow renders that claims obviousness also holds no merit. The dots of Wankow are not used in the cutting mechanism at all; therefore a correlation between instant invention and the vinyl spots cannot be made.

The Action states at point 6, pages 4-5, that the Applicants' arguments set forth in Applicants' Response filed April 1, 2009 were fully considered but not found persuasive. In particular, the Action states that Applicants' April 1, 2009 arguments attack references individually where the rejections are based upon combinations of elements, citing In re Keller, 208 USPQ 871 (CCPA 1981). The Action further states that the Office properly set forth each combination in the April 1, 2009 Action with appropriate consideration of the Graham factors. Id. at page 5. While Applicants respectfully submit that they have addressed the combination of references during prosecution of the instant application, Applicants set forth herein a more detailed response directed to the issue whether the subject prior rejections properly combined the cited references of record. For the reasons set forth below, it is respectfully submitted that the combinations of references in the Action were not valid combinations under existing law and thus did not form a sufficient basis for the rejection of the claims pending in the instant application.

In point 6, the Action refers to "the declaration," but does not say which declaration which is important because more than one declaration was submitted during prosecution. Applicants will presume the declaration referred to is the Declaration of Paul Vegliante dated July 23, 2008. The Office Action states that the Amendment dated April 1, 2009 contains argument beyond the scope of the evidence. Applicants respectfully traverse this objection and states that the arguments in the April 1, 2009 are fully supported by the Declaration. Nonetheless, Applicants submit herewith a Supplement Declaration of Paul Vegliante with supporting documentation demonstrating that the claimed invention is non-obvious due to a high level of commercial success and copying of the invention of the claims of the instant application.

As to the Examiner's use of a device according to Chuang, and the Action's statement that such device afforded attraction "of a minor nature, far less than the *device* of the present application," Applicant draws the Examiner's attention to the cohesion attraction of the present invention which holds the film to the rails with far more strength than that of Chuang.

In point 1 of the Action, page 2, claims 1, 5, 11-14, 17, 20-23, 40, 42, 43 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas in view of Wankow with supporting evidence from Boda, Union and Tsai as set forth in the previous action of July 3, 2007. The Applicants respectfully traverse this rejection.

As an initial matter, it is respectfully submitted that there is simply no teaching, suggestion or motivation to combine the primary references, Lucas and Wankow.

Wankow discloses an ordinary carton containing material wrapped around a roll and having on the lower front edge of the carton a fixed saw blade for cutting the material as it is pulled out of the carton. While Wankow does disclose vinyl dots for preventing the material from retracting into the box during use, Wankow does not teach, suggest or motivate the ordinary skilled worker to modify a simple, fixed blade carton to build a complexly-made movable slide cutter as disclosed in Lucas. Indeed, Lucas and Wankow are so unlike in structure and function that it is only through hindsight that one could combine them. To state it simply, Wankow is an ordinary wrapper carton with a fixed saw blade. Lucas is a much more complex film cutter with a movable blade assembly that includes a roller/blade/housing system. See Lucas, Col. 3, lines 25-47; Figures 2 and 3. To cut film with Lucas, one must move the blade across the film; to cut film with Wankow, one must tear the film across the blade. Clearly, Lucas and Wankow were trying to solve problems from completely different directions. Thus, neither reference points toward the other. See, e.g., Lucas at Col 3, lines 14-17 and Wankow at Col.2, lines 5-8. See, In re Mills, supra.

Other reasons make it incorrect to combine Lucas and Wankow to arrive at the invention of the instant claims as was done in the Action. First, there is no teaching, suggestion or motivation in these prior art references to pick and choose one element of Wankow (the vinyl spots) out of all the other elements of that reference to combine with Lucas. See SmithKline Diagnostics, cited above. Second, there is no teaching, suggestion or motivation to move the vinyl spots of Wankow to the top of a set of rails between which a moveable blade rolls in a channel, as opposed to fixing a blade to the lower side of the simple "box" carton of Wankow. Third, there is simply no objective, non-hindsight, evidence that the skilled artisan, upon reading Wankow, would be taught, suggested or motivated to design the movable slide cutter of Lucas. In fact, the opposite is true: the skilled worker in possession of Wankow would most likely design another fixed blade cutter.

Boda, Urion and Tsai are cited in the Action as supporting the combination of Lucas and Wankow. It is respectfully submitted that these references do not support the combination

because each such reference discloses designs that are distinct from both Lucas, Wankow and the invention claimed in the instant application.

In particular, Boda is merely a support panel for a rotary paper cutter and does not disclose a blade housing supported by rails. See Figure 1 of Boda. Urion also differs from Lucas and Wankow. Urion discloses a cutter assembly with a track member and purports to use a cutter slide with downwardly extending projections for immobilizing and tensioning a sheet prior to severing it. See Abstract and Figure 2 of Urion. Tsai is also far removed from the cited art and the instant invention. Tsai discloses a roller-based film cutter assembly which utilizes four rollers to press and tension film against a track for stabilizing the film to be cut. See Abstract and Figure 1 of Tsai. Thus, while Boda, Urion and Tsai may mention the use of plastic molding, they do not aid in the attempt to use the combination of Lucas and Wankow to make out a prima facie case of obviousness of the instant claims.

Thus, there is no basis to combine Lucas and Wankow, with or without the aid of Boda, Urion and Tsai, to arrive at claims 1, 5, 11-14, 17, 20-23, 40, 42, 43 and 44 of the instant application. Therefore, it is respectfully submitted that this rejection be withdrawn.

In point 2 of the Action, page 2, claims 1, 5, 11-14, 20-23, 38-40 and 42-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chuang and an artifact submitted by a third party on 8/25/08 in co-pending case 09/741,521 entered into the record thereof as 09741521MA in view of Lucas in view of Wankow, "Phtalate Ester plasticizers-Why and How they are Used" and Gearhart as set forth previously in the Action dated 10/1/08. Applicants respectfully traverse this rejection.

As set forth above, there is no basis to combine Lucas and Wankow to arrive at any claims of the instant application. In addition, there is no basis to combine these references with the primary reference Chuang to arrive at the recited claims. Chuang discloses a plastic film cutter with a push button having rollers disposed upon the bottom surface of the push button cutting means. The push button/roller combination is said to inhibit the plastic film from gathering at the bottom of the cutter blade because the film is pressed and pulled tightly during the cutting operation. See Chuang, Col. 2, lines 1-14; Figures 3C and 3D.

Chuang cannot be properly combined with the combination of Lucas and Wankow for reasons that are virtually the same as those militating against the Lucas/Wankow combination

alone, even with impermissible hindsight picking and choosing. That is, simply stated, Wankow is an ordinary wrapper carton with a fixed saw blade. Chuang is a much more complex film cutter with a movable roller blade assembly. To cut film with Chuang, one must move the blade across the film; to cut film with Wankow, one must move the film across the blade. In addition, Chuang does not disclose the use of an adhesive or plasticizer. Clearly, Chuang and Wankow, as with Lucas and Wankow, were trying to solve problems from two different directions.

In this rejection, the Action has still further increased the number of references to reject the claims. For the following reasons, applicants respectfully submits that, on an objective basis, this complex six part combination of the prior art, including art outside the field of the instant invention, can only be made with the benefit of impermissible hindsight and the picking and choosing of claim elements from disparate art. See, e.g., KSR; In re Jones; SmithKline and In re Oetiker; Para-Ordinance, as cited above.

Notwithstanding the impermissible nature of the combinations of this rejection, as established by Federal Circuit law, it is respectfully submitted that the combinations themselves are incorrect for additional reasons.

First, as stated above, there is simply no teaching, suggestion or motivation to combine Lucas and Wankow. There is no objective evidence to show that Wankow teaches, suggests or motivates the ordinary skilled worker to modify a simple, fixed blade carton to build a complexly-made movable slide cutter as disclosed in Lucas. Indeed, Lucas and Wankow are so unlike in structure that it is only through hindsight use of applicants' claims that one could possibly combine them.

Second, as explained above, there is no objective evidence to make a non-hindsight combination of Chuang, Lucas and Wankow. Wankow is an ordinary wrapper carton with a fixed saw blade. Chuang is a much more complex film cutter with a movable roller blade assembly. Id. To cut film with Chuang, as with Lucas, one must move the blade across the film; to cut film with Wankow, one must move the film across the blade. In addition, while the Examiner believes that there is something functioning on the rails of a model allegedly made to attract or adhere film, the objective evidence is that the reference Chuang does not teach, suggest or motivate the use of an adhesive or plasticizer on top of the rails of Chuang on the basis of Lucas and/or Wankow. As explained above, Chuang, Lucas and Wankow, were trying to solve

the problem of maintaining some stability of the material to be cut starting from different directions: Chuang (roller assembly), Lucas (possibly friction) and Wankow (vinyl spot).

Third, this rejection is based upon an expanded combination of Chuang, Lucas, Wankow and the Phthalate reference and Gearhart. The Phthalate and Gearhart references were addressed at length in Applicants' April 1, 2009 Amendment and such need not be repeated here. In sum, the Phthalate reference does not teach or suggest the use of phthalate ester plasticizers on film cutting rails. It merely discusses the use of plasticizers generally. Similarly, Gearhart teaches co-extrusion of PVC to bond a capstock material generally and does not point to or suggest film cutting rails. There is no evidentiary basis to combine these references with the teachings of Lucas and Wankow et al. in light of the Supreme Court's admonition in KSR, supra, that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. . . . It can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the element in the way the claimed new invention does." KSR, 550 U.S. at 418-419.

Again, it is important to guard against hindsight combinations of references that in no way teach or suggest the combination. In addition, it is further highly important that there be "actual evidence" supporting the combination. In re Dembiczak, supra. Here, there is absolutely no evidence that the skilled artisan would reach out to the Phthalate reference and Gearhart, which are in no way directed to cutting devices, and combine them with Chuang, Lucas and Wankow. It is respectfully submitted that the combination has been made here with reference to the claimed invention as a guide. Therefore, it is respectfully submitted that this rejection be withdrawn.

At point 3 of the Action, page 3, claims 1 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chuang in view of Lucas in view of Wankow, the "Phthalate reference, and Gearhart "as set forth above" (point 2) and in further view of Urion. Applicants incorporate herein by reference all of the arguments and responses made in response to the rejection in point 2 and if fully set forth herein.

In summary, in this rejection, the Action has still further increased the number of references to reject the claims. For the following reasons, applicants respectfully submit that, on an objective basis, this complex combination of the prior art, including art outside the field of

the instant invention, can only be made with the benefit of impermissible hindsight and the picking and choosing of claim elements from disparate art. See, e.g., KSR; In re Jones; SmithKline; In re Oetiker and Para-Ordnance, as cited above. Notwithstanding the impermissible nature of the combinations of this rejection, as established by Federal Circuit law, it is respectfully submitted that the combinations themselves are incorrect for many reasons.

First, as stated above with respect to Applicants' response to the rejection in point 2, there is simply no teaching, suggestion or motivation to combine Lucas and Wankow for the reasons stated therein. Second, as also explained in Applicants' response to the rejection in point 2, there is no objective evidence to make a non-hindsight combination of Chuang, Lucas and Wankow. Third, as explained above, Chuang, Lucas and Wankow, were trying to solve the problem of maintaining some stability of the material to be cut starting from different directions: Chuang (roller assembly), Lucas (possibly friction) and Wankow (vinyl spot).

Fourth, as stated with in Applicants' response to the rejection in point 2, this rejection is based upon an expanded combination of Chuang, Lucas, Wankow and the Phthalate reference and Gearhart. The deficient teachings of the Phthalate reference and Gearhart were elucidated in Applicants' April 1, 2009 Amendment, and thus need not be set forth in detail here. In sum, the Phthalate reference does not teach or suggest the use of phthalate ester plasticizers on cutting rails, it merely discusses the use of such plasticizers generally. Similarly, Gearhart teaches co-extrusion of PVC to bond a capstock material generally.

Fourth, Urion does not teach or suggest a combination with it and Chuang, Lucas, Wankow, the Phthalate reference and Gearhart, and none of the latter five references teach or suggest their combination with Urion in this six part combination. Urion discloses a cutter assembly which can be made with injection molding and further purports to disclose side or wall segments that appear to be involved immobilizing and tensioning a sheet prior to severing it. While Urion suggests that its cutting assembly can be molded out of a suitable plastic material, such as acetal resin, there is no teaching or suggesting of Chuang's roller assembly and, that of Lucas, the simple box carton of Wankow, and is a cutter device, not a general reference pertaining to plasticizers (the Phthalate reference) or PVC co-extrusion methods (Gearhart).

Applicants respectfully submit that there is no objective evidence to combine these six references in light of the Supreme Court's admonition in KSR, supra, that "a patent composed of

several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. . . . It can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the element in the way the claimed new invention does." KSR, 550 U.S. at 418-419.

Again, it is important to guard against hindsight combinations of references that do not teach or suggest the combination. In addition, it is further highly important that there be "actual evidence" supporting the combination. In re Dembiczak, supra. Here, there is absolutely no evidence that the skilled artisan would reach out to the Phthalate reference and Gearhart, which are in no way directed to cutting devices, and combine them with Chuang, Lucas and Wankow. It is respectfully submitted that the combination has been made here with reference to the claimed invention as a guide. Therefore, it is respectfully submitted that this rejection be withdrawn.

In point 4 of the Action, page 3, claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Chuang in view of Lucas in view of Wankow, the "Phthalate" reference and Gearhart, "as applied to claims 1, 5, 11-14, 20-23, 38-40, 42-44 above," and further in view of Chiu. Applicants respectfully traverse this rejection.

In this rejection, the Action has again further increased the number of references to reject the claims. For the following reasons, applicants respectfully submits that, on an objective basis, this complex combination of the prior art, including art outside the field of the instant invention, can only be made with the benefit of impermissible hindsight and the picking and choosing of claim elements from disparate art. See, e.g., KSR; In re Jones; SmithKline and In re Oetiker; Para-Ordnance, as cited above.

Notwithstanding the impermissible nature of the combinations of this rejection, as established by Federal Circuit law, it is respectfully submitted that the combinations themselves are incorrect for many reasons.

First, as stated above, there is simply no teaching, suggestion or motivation to combine Lucas and Wankow. There is no objective evidence to show that Wankow teaches, suggests or motivates the ordinary skilled worker to modify a simple, fixed blade carton to build a complexly-made movable slide cutter as disclosed in Lucas. Indeed, Lucas and Wankow are so

unlike in structure that it is only through hindsight use of applicants' claims that one could possibly combine them.

Second, as explained above, there is no objective evidence to make a non-hindsight combination of Chuang, Lucas and Wankow. Wankow is an ordinary wrapper carton with a fixed saw blade. Chuang is a much more complex film cutter with a movable roller blade assembly. Id. To cut film with Chuang, as with Lucas, one must move the blade across the film; to cut film with Wankow, one must move the film across the blade. In addition, while the Examiner believes that there is something functioning on the rails of a model allegedly made to attract or adhere film, the objective evidence is that the reference Chuang does not teach, suggest or motivate disclose the use of an adhesive or plasticizer on top of the rails of Chuang on the basis of Lucas and/or Wankow. As explained above, Chuang, Lucas and Wankow, were trying to solve the problem of maintaining some stability of the material to be cut starting from different directions: Chuang (roller assembly), Lucas (possibly friction) and Wankow (vinyl spot).

Third, this rejection is based upon an expanded combination of Chuang, Lucas, Wankow and the Phthalate reference and Gearhart. The deficient teachings of the Phthalate reference and Gearhart were elucidated in Applicants' April 1, 2009 Amendment, and thus need not be set forth in detail here. In sum, Applicants pointed out therein that the Phthalate reference does not teach or suggest the use of phthalate ester plasticizers on cutting rails, it merely discusses the use of such plasticizers generally. Similarly, Gearhart teaches co-extrusion of PVC to bond a capstock material generally. Applicants further pointed out that there was no basis to combine these references with the teachings of Lucas and Wankow et al. in light of the Supreme Court's admonition in KSR, supra, that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. . . . It can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the element in the way the claimed new invention does." KSR, 550 U.S. at 418-419. April 1, 2009 Amendment at pages 8-9.

With respect to the Chiu reference, the Examiner's rejection is silent on the significance of adding Chiu to the combination with respect to 17 specifically. Nevertheless, Applicants respectfully traverse the Action's assertion that the invention of claim 17 is obvious in light of

the combination of Chiu with the other references cited. It is respectfully submitted that Chiu does not disclose the apparatus of claim 1 and does not further comprise an adhesive layer adhered to a elongated rail base on a surface opposite a rail. Applicant further requests that the Examiner state the grounds for citing Chiu in this rejection and combining Chiu with the other references forming the basis of the rejection of claim 17.

Again, it is important to guard against hindsight combinations of references that in no way teach or suggest the combination. In addition, it is further highly important that there be "actual evidence" supporting the combination. In re Dembiczak, supra. Here, there is absolutely no evidence that the skilled artisan would reach out to the Phthalate reference and Gearhart, which are in no way directed to cutting devices, and combine them with Chuang, Lucas, Wankow and Chui. It is respectfully submitted that the combination has been made here with reference to the claimed invention as a guide. Therefore, it is respectfully submitted that this rejection be withdrawn.

In point 5 of the Action, page 3, claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chuang in view of Lucas in view of Wankow, the "Phthalate reference and Gearhart as set forth above, and further in view of Keene. Applicants respectfully traverse this rejection.

Applicants repeat and incorporate herein their arguments and objections with respect to the combinations of Chuang, Lucas and Wankow and Phthalate reference and Gearhart made with respect to the rejection in points 1-4. Applicants further respectfully submit that the Chuang, Lucas, Wankow, Phthalate reference, Gearhart in view of Keene is not a proper combination. Keene does not properly add to the combination of the above references, nor does it teach or suggest to the skilled worker the subject matter of the rejected claims. As stated more fully in Applicants' April 1, 2009 Amendment, Keene teaches an apparatus for severing a web. Keene does not teach or suggest at least one rail for attracting the plastic wrap to the rail, or the material that would be used therefor. To the contrary, Keene uses rollers to hold the plastic wrap down. Accordingly, Keene does not properly form a part of the combination. Applicants therefore submit that this rejection be with drawn.

In point 7 of the Action, it is said that the curvature of the blade housing of the instant invention is a matter of appearance, not function. The Action further states that "one of ordinary

skill can change the appearance without changing the function and the change would meet the limitation of the claim -- that the form be of a curved nature. Having function that is not recognized by the prior art does not make the change in form non-obvious. Applicants respectfully disagree and traverse this finding and states that it is mistaken with respect to the configuration of the claimed housing.

The Applicants are not arguing that the curved end surface of the housing was made, or is, for appearance sake. Nor are Applicants arguing that only the function of the curved housing was unknown in the art. Applicant's position, as clearly stated in the April 1, 2009 Amendment was that the curved housing was designed "to act in conjunction with the rails to allow the film to remain flat during sliding of the blade housing along the rails." *Id.* at page 9. Thus, Applicants' housing design is different from the prior art in both structure and function.

Objective Evidence of Non-Obviousness

In point 8 of the Action, pages 6-9, the 7/25/08 Declaration of Paul Vegliante was found insufficient. Applicants disagrees with this assessment, but nevertheless respond as follows.

As set forth in the Supplemental Declaration of Paul Vegliante, submitted together with this Response, the objective evidence supporting the patentability of the claims in the instant application is overwhelming, and constitutes the "hard" evidence requested in point 8 of the Action.

Commercial Success

On the issue of commercial success, applicants respectfully submit that the Action over states the weight of applicants' burden to show commercial success and its nexus to the claimed invention. As the Federal Circuit held, the standard for showing a nexus between commercial success and the claimed invention is as follows:

A prima facie case of nexus is generally made out when the patentee shows that:

[1] there is commercial success, and [2] the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent.

Demaco Corp. v. F.Von Langsdorff Licensing Limited, 851 F.2d 1387, 1392-1393 (Fed. Cir. 1988).

Applicants have by far met this standard

Here, as set forth in the Plastic Wrap Market Report ("PWMR"), an *entirely independent study* of the relevant plastic wrap and cutter market, and Mr. Vegliante's Supplemental Declaration, there is no credible dispute that (1) AEP's, applicants' assignee, slide film cutter was a huge commercial success, and (2) the commercial AEP slide cutter is what is covered by at least independent claim 1 of the instant application. In addition, the PWMR demonstrates that by 2005, AEP's slide cutter penetrated 25 percent of a market dominated by huge and long-established competitors. Moreover, and importantly, AEP's high sales (on the order of 30-70 million) of its cutter have been made without any advertising and promotion. Those sales were due to the slide cutter claimed in the instant application. Thus, on the basis of this evidence alone, and as a matter of both law and fact, applicants' have made a prima facie case of commercial success and a nexus between that success and the claimed invention. See Demaco Corp. supra.

In addition, patent applications for the slide cutter of the instant invention have been granted in Canada, Australia and New Zealand, the only foreign countries where such applications were filed.

At point 8 of the Action, pages 6-8, the Action criticized and objected to Applicants' sales and market data on the ground that they are estimates, and thus "flawed," and therefore are not evidence of commercial success. Applicants respectfully submit that that Action is wrong as a matter of law on this point. As the Federal Circuit held, sales estimates are proper indicia of commercial success. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1382 (Fed. Cir. 1986)("estimated \$14.5 million in 1984" evidence of commercial success). In any event, Applicants have submitted the independent, unbiased PWMR Report which should clear up any doubts the Examiner may have regarding sales.

Copying

As demonstrated by the Vegliante Declarations and the Exhibits thereto, the slide cutter of the instant application was and is the subject of worldwide copying which is a fact that, standing almost alone, can be determinative of non-obviousness. Advanced Display Systems, Inc. v. Kent State University, 212 F.3d 1272 (Fed. Cir. 2000)("wholesale copying" "could be determinative on the issue of obviousness") (emphasis added). The Vegliante Declarations and the Exhibits thereto point to a litany of copiers of the instant invention; just to name a few:

- Reynolds Company
- Anchor Wrap Packaging
- Diamant Films Inc.
- Pliant Corporation
- Polyvinyl Company
- Metal Edge International, Inc.
- Durable Packaging International

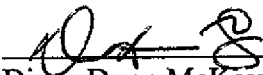
It is respectfully submitted that the great weight of the evidence on commercial success and copying further demonstrates that the claims of the instant application are patentable over 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, Applicants submit that all pending claims are in condition for allowance and request that all claims be allowed. The Examiner is invited to contact the undersigned should he believe that this would expedite prosecution of this application. It is believed that no fee is required. The Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 13-2165.

Respectfully submitted,

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